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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/627,694 07/28/00 HOUGHTON

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HM12/1010

EXAMINER

HARRIS, A

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

10/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/627,694

Applicant(s)

HOUGHTON ET AL.

Examiner

Alana M. Harris, Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-28 and 34-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. Claims 1-40 are pending.

Claims 1-28 and 34-40, drawn to non-elected inventions are withdrawn from examination.

Claims 29-33 are examined on the merits.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Priority

3. Upon examining claims 29-33 (see First Action on the Merits, mailed May 16, 2001) the instant application was granted the effective filing date of December 10, 1997 (PCT/US97/22669). The provisional documents, 60/036,419 (filing date February 18, 1997), 60/032,535 (filing dated December 10, 1996) and 60/180,651 (filing date January 26, 2000) from which Applicant requested priority benefit were located and the priority was reestablished for claims 29-33 as December 10, 1996.

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Withdrawn Rejections

Claim Rejections - 35 U.S.C. § 112

4. The rejection of claims 29-31 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in light of Applicants' arguments.

Claim Rejections - 35 U.S.C. § 103

5. The rejection of claims 29-33 under 35 U.S.C. 103(a) as being unpatentable over Naftzger et al. (Proc. Natl. Acad. Sci. USA, 93:14809-14814, December 1996), in view of Ausubel et al. (Current Protocols In Molecular Biology, Volume 2, Section 2, Unit 16.8-16.11:pages 16.9.1-16.11.7, 1990/ Referenced on the IDS) is withdrawn light of the new established priority date of December 10, 1997, the filing date of provisional application 60/032,535.

New Grounds of Rejection

Claim Rejections - 35 U.S.C. § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 29, 31 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Houghton et al. (Annals New York Academy of Sciences 690:59-38, August 12, 1993). Houghton discloses a human gp75 differentiation antigen derived from the human melanoma cell line, SK-MEL-19 expressed in the non-human cell line, mouse L cells. These cells are mouse L fibroblasts (see page 65, "The gp75 Antigen..." section).

Claim Rejections - 35 U.S.C. § 103

8. Claims 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houghton et al. (Annals New York Academy of Sciences 690:59-38, August 12, 1993), in view of Ausubel et al. (Referenced on IDS, page 2, Paper number 4). The teachings of Houghton are listed in paragraph 7. The Houghton document does not teach a non-human cell line, such as an insect cell line that expresses a human differentiation antigen derived from human melanocytes.


However, Ausubel teaches the preparation of insect cell cultures and expression of proteins, such as a human tyrosinase differentiation antigen in insect cells using baculoviral expression systems. It would have been *prima facie* obvious to one of ordinary skill in the art at the time the claimed invention was made to use the expression system, culture methods and harvesting techniques disclosed by Ausubel for the successful expression of the human tyrosinase differentiation antigen cDNA derived from human melanocytes contained within an expression vector to promote expression of the said antigen in insect cells. One of ordinary skill in the art would have been motivated to do so with a reasonable expectation of success by teachings in

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Ausubel of the great likelihood of obtaining biologically active products from such methods and host cells due to the baculovirus' efficient promoter strategy and the high infection rate of insect host cells. Furthermore, one of ordinary skill in the art would have been motivated to do so with a reasonable expectation of success because it is art known that sources of altered antigen can induce effective immune responses, such as tumor rejection.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris whose telephone number is (703)306-5880. The examiner can normally be reached on Monday through Friday from 6:30 am to 4:00 pm, with alternate Fridays off. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703)308-4310. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0196.

Alana M. Harris, Ph.D.
Patent Examiner, Group 1642
October 7, 2001


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